REMARKS

The present response amends claims 19 and 27-32. No claims have been added. Therefore, claims 1-32 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 101 Rejection:

The Examiner rejected claims 19-32 under 35 U.S.C. § 101 because the claimed invention "is directed to non-statutory subject matter," "lacks patentable utility," "is inoperative and therefore lacks utility," and "is not supported by either a computer readable medium/hardware asserted utility or a well established utility." Applicants respectfully traverse this rejection. However, in order to expedite prosecution, claims 19 and 27-32 have been amended to recite a computer implemented method and a tangible, computer readable medium, respectively. Applicants respectfully request removal of the § 101 rejections.

Section 112, First Paragraph, Rejection:

The Examiner rejected claims 19-32 under 35 U.S.C. § 112, first paragraph. Specifically, Examiner contends that since the claimed invention "is not supported by either a computer readable medium/hardware asserted utility or a well established utility for the reasons set forth above [regarding the § 101 rejection], one skilled in the art clearly would not know how to use the claimed invention." Applicants respectfully traverse this rejection. The utility of document conversion is well understood in the art. Also, as noted above to expedite prosecution, method claim 19 has been amended to a recite computer implemented method and claims 27-32 have been amended to recite tangible, computer readable mediums s. For at least the reasons presented above, Applicants respectfully request removal of the § 112 rejections.

Double Patenting Rejection:

The Examiner provisionally rejected claims 1-32 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of co-pending application Serial No. 10/090,893. If and/or when this rejection becomes non-provisional, Applicants will consider filing a terminal disclaimer or present reasons traversing the rejection.

Section 103(a) Rejection:

The Examiner rejected claims 1-32 under 35 U.S.C. § 103(a) as being unpatentable over Mendez et al. (U.S. Patent 6,708,221) (hereinafter "Mendez") in view of Helgeson et al. (U.S. Patent 6,643,652) (hereinafter "Helgeson"). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, although Mendez describes synchronization of documents in a networked environment, Mendez does not describe synchronization that restores one or more formats for content of the document in the format supported by the server excluded from the small device document. The Examiner's cited reference (Mendez, column 15, line 50 – column 16, line 18) teaches that when multiple versions of a workspace element have been modified, the synchronization module computes the changes to each version and reconciles the modified versions. There is nothing in this citation, nor elsewhere in Mendez, that teaches restoring previously excluded formats for content during synchronization. Claim 1 refers to "formats for content" which are distinguishable from file types. For example, excluding and restoring format for content is different than converting data from one file type to another (e.g. converting from MS Word to WordPerfect). In conventional file format conversion processes, such as those taught by Mendez and Helgeson, lost format for content cannot be restored. Neither Mendez nor Helgeson, alone or in combination, teaches or suggests synchronization that restores previously excluded formats for content.

The Examiner's citation in Helgeson describing "save and restore" is directed at saving and restoring object state for business objects, which are Java objects representing some entity in a business application. (Helgeson, column 13, lines 12-16). The cited passage has nothing to do with excluding or restoring formats for content during synchronization of documents. Thus, Helgeson does not overcome the above mentioned deficiencies of Mendez.

For at least the reasons above, the rejection of independent claim 1 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks as discussed above in regard to claim 1 apply to independent claims 10, 19, and 27.

Regarding claim 3, Mendez in view of Helgeson does not teach or suggest comparing modified content of the modified version of the small device document to corresponding content of the document in the server format <u>to determine one or more formats for the modified content of the modified version of the small device document to be merged with the document in the server format.</u> The Examiner's citation (Mendez, column 11, lines 12-30) discloses routines for requesting and comparing version information, routines for comparing local and remote versions of a workspace element only to see if one or both versions have been modified, and routines for performing an appropriate synchronizing responsive action. There is nothing in this citation, nor elsewhere in Mendez, that teaches comparing the documents to determine <u>formats</u> for modified content to be merged.

The Examiner's other second citation (Mendez, column 16 lines 8-18) describes how the general synchronization routine and the content-based synchronization module deal with new workspace elements and preexisting workspace elements to which new workspace elements will be merged, by setting their status to "modified", setting their previous status to the null set, and merging the documents, which are determined to have no conflicts. Rather than teaching merging the modified content of the modified version of the small device into the document in the server format <u>in accordance with the determined one or more formats for modified content,</u> as the Examiner contends, this

citation instead teaches one of the simplest cases for merging documents, one in which no conflict exists. Mendez in view of Helgeson teaches nothing about merging the modified content in accordance with <u>determined one or more formats</u> for modified content at the Examiner's cited passage or anywhere else.

For at least the reasons above, the rejection of dependent claim 3 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks as discussed above in regard to claim 3 apply to dependent claims 12, 20 and 28.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

<u>Information Disclosure Statements</u>:

Applicants note that an information disclosure statement with accompanying Forms PTO-1449 was submitted on September 4, 2003. The Examiner has returned a signed and initialed Form PTO-1449, however, reference "A4" was not initialed. Applicants request the Examiner to carefully consider reference "A4" and return a copy of the signed and initialed Form PTO-1449 from this statement. Applicants have included a copy of the Form PTO-1449 for the Examiners convenience. Applicants also note that an additional information disclosure statement is being submitted herewith.
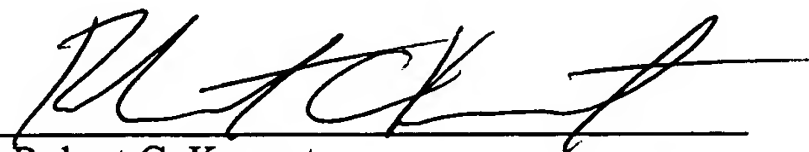
CONCLUSION

Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10700/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard

☒ Copy of previously submitted form PTO-1449

☒ Information Disclosure Statement

Respectfully submitted,

Robert C. Kowert
Reg. No. 39,255
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

Date: August 22, 2005